

REMARKS

The above amendments and following remarks are submitted under 37 C.F.R. 1.116 in response to the final official action of the Examiner (i.e., Paper No. 4) mailed January 30, 2004. This amendment is deemed to fully respond to all objections and rejections of the Examiner. Thus, claims 1-20, being all pending claims, are now expected to be in condition for allowance. Entry of this amendment and reconsideration to that end is respectfully requested.

The Examiner has rejected claims 4, 5, 10, 15, and 20 under 35 U.S.C. 112, second paragraph, as utilizing certain trademarks. In response thereto, the appropriate claim amendments have been made above.

The Examiner has rejected claim 1-3, 6-8, and 11-19 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,370,588 B2, issued to Gebauer (hereinafter referred to as "Gebauer"). This ground of rejection is respectfully traversed as to the amended claims for the following reasons.

The standard for a finding of anticipation is provided in MPEP 2131, which provides in part:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814
F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The rejection is respectfully traversed because Gebauer does not "either expressly or inherently describe" "each and every element" of the claimed invention as amended.

Specifically, claim 1 is limited "wherein said transaction request has one of a plurality of protocols". The user terminal of Gebauer, on the other hand, can only make service requests in a single format (i.e., HTML). Column 3, lines 55-56, states:

....transaction data transferred from the user over the internet in HTML format....

As a result, Gebauer does not meet the limitations of the claimed invention, because Gebauer receives only service requests in a single format (i.e., HTML). Gebauer has a "gateway" which operates with only a single format (i.e., HTML). This is in direct contrast to Applicants' specification at page 8, lines 15-19, which states:

A plurality of adapters convert each of the differing request formats into a single input format for the single generic gateway. In this manner, a client may make a service request via C++, ASP (i.e., an active server page from a web browser), or other format.

Therefore, the rejection of claim 1 as amended, and any claim depending therefrom, is respectfully traversed because Gebauer does not permit users to utilize a plurality of protocols for transaction requests because it does not have the claimed "generic gateway".

Claim 2 depends from claim 1 and is further limited to a plurality of adapters between the user terminal and the "generic gateway" wherein there is a different adapter (i.e., "adapter" is a structural limitation") for each of the permitted protocols. In making his rejection, the Examiner confusingly states:

"...where the clients (sic) request is adapted to use each service 70 and 72.

This misquotes the reference, misstates the clear operation thereof, and is legally irrelevant, because it does not address the claim limitation which requires the use of a plurality of different protocols. The rejection of claim 2 is respectfully traversed.

In rejecting claims 6-8, the Examiner states:

Claims 6-8 do not recite limitations above the claimed invention set forth in claims 1-3 and are therefore rejected for the same reasons set forth in the rejection of claims 1-3 above.

This statement is clearly erroneous factually, because claims 6-8 are limited by an additional "server" containing the "generic gateway" which is not limiting of claims 1-3. Therefore, in addition to the arguments made above with regard to the rejection of claims 1-3, the rejection of claims 6-8 is also respectfully traversed as based upon this clearly erroneous finding of fact.

In rejecting claims 11 and 16, the Examiner states:

Claims 11 and 16 do not recite limitations above the claimed invention set forth in the combination of claims 1 and 2 and are therefore rejected for the same

reasons set forth in the rejection of claims 1 and 2 above.

This statement is clearly erroneous factually as can be readily appreciated by simply reading the claims. In addition, the scope of claims 11 and 16 are different as a matter of law. Claims 1 and 2 are apparatus claims. Claim 11 is a method claim primarily limited by process steps rather than apparatus structure. Furthermore, claim 16 is an apparatus claim having "means-plus-function" limitations, providing a different statutory basis for patentability. For that reason, examination of claim 16 is to be performed in accordance with MPEP 2181, et seq. Therefore, the rejection of claims 11 and 16 are respectfully traversed as a matter of law in addition to the arguments made above.

In rejecting claims 12 and 17, the Examiner states:

In both cases, once the request has been adapted (converted, processed) it is directed to the actual service provider via the connection between them).

Thus, instead of addressing Applicants' claim limitations, the Examiner has attempted to redefine them to better comport with his reading of Gebauer. This is procedurally incorrect as a matter of law. The Examiner is reminded that Applicant may be his own "lexicographer" as a matter of law. The Examiner is required to utilize Applicants' definitions. He is not free to choose his own. Page 26, lines 5-8, of the specification should be sufficient to provide the Examiner with a working definition of the claim limitation, "connector". The rejection of claims 12

and 17 are respectfully traversed as contrary to controlling law and as based upon clearly erroneous findings of fact.

In rejecting claims 13 and 19, the Examiner states:

Claims 13 and 19 do not recite limitations above the claimed invention set forth in claim 3 and are therefore rejected for the same reasons set forth in the rejection of claim 3 above.

This statement is clearly erroneous factually as can be readily appreciated by simply reading the claims. In addition, the scope of claims 13 and 19 are different as a matter of law. Claim 3 is an apparatus. Claim 13 is a method claim primarily limited by process steps rather than apparatus structure. Furthermore, claim 19 is an apparatus claim having "means-plus-function" limitations, providing a different statutory basis for patentability. For that reason, examination of claim 19 is to be performed in accordance with MPEP 2181, et seq. Therefore, the rejection of claims 13 and 19 are respectfully traversed as a matter of law in addition to the arguments made above.

In rejecting claim 14, the Examiner states:

Referring to claim 14, Gebauer has taught the method wherein said one of said plurality of formats further comprises an active server page (Gebauer figure 4, elements 70 and 72).

The Examiner has confused the protocol of the "service request" of claim 14, which has the format of an Active Server Page (ASP), with the service of Gebauer which may be scripted as an ASP. In the claim, a service request, formatted as an ASP, is transferred

to the server via the publically accessible digital data communication network. In Gebauer, a service request, formatted as an HTML page, is transferred to the server via the Internet, which may activate ASP scripting. The user terminal of Gebauer can only make service requests in HTML. The rejection of claim 14 is respectfully traversed as based upon clearly erroneous findings of fact.

The Examiner makes the same mistake with his rejection of claim 15. In fact, the citation of the Examiner specifically contradicts the Examiner's position. It states at column 8, lines 24-25:

On the other hand, open services may have server-side scripting in a variety of common commercial languages..... (emphasis added)

As with the ASP script, the Visual Basic script exists only on the "server-side". It is not transferred from the user terminal. The rejection of claim 15 is respectfully traversed as based upon clearly erroneous findings of fact.

As with his rejection of claims 12 and 17, the Examiner impermissibly "bends" the terminology of claim 18 to comport with his rejection. The rejection of claim 18 is respectfully traversed as inconsistent with controlling law.

Claims 1-3, 6-8, 11-13, and 16-19 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,845,267, issued to Ronen (hereinafter referred to as "Ronen").

This ground of rejection is respectfully traversed as to the amended claims for the following reasons.

In rejecting claim 1, the Examiner has again impermissibly redefined Applicants' claim limitations to suit his theory of rejection. He states:

....transaction server 121 acts as a gateway between user terminal 101 and server 126.

The Examiner's attention is directed to the specification at page 8, lines 9-12, and page 6, lines 2-4, for Applicants' definition of a "generic gateway". As a matter of law, the Examiner must utilize this definition for his examination. A "generic gateway" is not a "server".

In his response to Applicants' arguments at page 10, paragraph 41, the Examiner states:

While applicant defines this term in the specifications, the claims stand on their own merit....

Thus, even though the Examiner agrees that Applicants have properly defined the term "generic gateway", he refuses to apply this definition in opposition to controlling law. It is respectfully suggested that the Examiner consult MPEP 2111.01 which provides:

2111.01 Plain Meaning [R-1]

APPLICANT MAY BE OWN LEXICOGRAPHER

Applicant may be his or her own lexicographer **>; however any special< meaning assigned to *>a< term ** "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the

invention." *Multiiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). >See also *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) and MPEP § 2173.05(a).<

The rejection of claim 1 is respectfully traversed as inconsistent with controlling law.

In his rejection of claim 2, the Examiner repeats his legal error by stating:

....where the adapters are that which adapt the request to be processed by the server.

Not only is this statement completely inconsistent with controlling law, it does not even make any sense. The Examiner is simply not permitted to redefine Applicants' claim limitations to meet his rejection theories. The rejection of claim 2 is respectfully traversed.

In rejecting claims 6-8, the Examiner states:

Claims 6-8 do not recite limitations above the claimed invention set forth in claims 1-3 and are therefore rejected for the same reasons set forth in the rejection of claims 1-3 above.

This statement is clearly erroneous factually, because claims 6-8 are limited by an additional "server" containing the "generic gateway" which is not limiting of claims 1-3. Therefore, in addition to the arguments made above with regard to the rejection of claims 1-3, the rejection of claims 6-8 is also respectfully traversed as based upon this clearly erroneous finding of fact.

In rejecting claims 11 and 16, the Examiner states:

Claims 11 and 16 do not recite limitations above the claimed invention set forth in the combination of claims 1 and 2 and are therefore rejected for the same reasons set forth in the rejection of claims 1 and 2 above.

This statement is clearly erroneous factually as can be readily appreciated by simply reading the claims. In addition, the scope of claims 11 and 16 are different as a matter of law. Claims 1 and 2 are apparatus claims. Claim 11 is a method claim primarily limited by process steps rather than apparatus structure. Furthermore, claim 16 is an apparatus claim having "means-plus-function" limitations, providing a different statutory basis for patentability. For that reason, examination of claim 16 is to be performed in accordance with MPEP 2181, et seq.

At paragraph 41 of page 10, the Examiner admits his obligation stating:

(with the exception of 'means plus function' type claims as applicant discusses)

Yet, the Examiner refuses to comply with the acknowledged requirements of controlling law. Therefore, the rejection of claims 11 and 16 are respectfully traversed as a matter of law in addition to the arguments made above.

In rejecting claims 12 and 17, the Examiner states:

....transferring said converted and processed service request from said generic gateway to an end service provider via a connector (Ronen figure 1 and column 5, line 43 - column 6, line 9 where the request is passed to the billing server (column 6, lines 10-13)).

Thus, instead of addressing Applicants' claim limitations, the Examiner has attempted to redefine them to better comport with his reading of Ronen. This is procedurally incorrect as a matter of law. The Examiner is reminded that Applicant may be his own "lexicographer" as a matter of law under MPEP 2111.01. The Examiner is required to utilize Applicants' definitions. He is not free to choose his own. Page 26, lines 5-8, of the specification should be sufficient to provide the Examiner with a working definition of the claim limitation, "connector". The rejection of claims 12 and 17 are respectfully traversed as contrary to controlling law and as based upon clearly erroneous findings of fact.

As with his rejection of claims 12 and 17, the Examiner impermissibly "bends" the terminology of claim 18 to comport with his rejection. The rejection of claim 18 is respectfully traversed as inconsistent with controlling law.

In rejecting claims 13 and 19, the Examiner states:

Claims 13 and 19 do not recite limitations above the claimed invention set forth in claim 3 and are therefore rejected for the same reasons set forth in the rejection of claim 3 above.

This statement is clearly erroneous factually as can be readily appreciated by simply reading the claims. In addition, the scope of claims 13 and 19 are different as a matter of law. Claim 3 is an apparatus. Claim 13 is a method claim primarily limited by process steps rather than apparatus structure. Furthermore,

claim 19 is an apparatus claim having "means-plus-function" limitations, providing a different statutory basis for patentability. For that reason, examination of claim 19 is to be performed in accordance with MPEP 2181, et seq. Therefore, the rejection of claims 13 and 19 are respectfully traversed as a matter of law in addition to the arguments made above.

Claims 1-13 and 16-20 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,397,220 B1, issued to Deisinger et al (hereinafter referred to as "Deisinger"). This ground of rejection is respectfully traversed for the reasons provided below.

Apparently in an attempt to avoid actually considering the teachings of Deisinger, the Examiner summarily rejects claim 1 on Deisinger Fig. 1. Though Applicants' Fig. 1 and Fig. 1 of Deisinger are similar, this just establishes that the preferred environment for each is similar. If the Examiner would kindly compare Fig. 3 of Deisinger with Fig. 4 of the present application, he would note that Deisinger has a plurality of different gateways (i.e., 236, 240, 244, 248, 252, 256, 260, and 264) to accommodate service requests of differing formats. Applicants', on the other hand, accommodate these differing formats through the use of a single generic gateway (i.e., GGATE 72). Therefore, the rejection of claim 1 is respectfully traversed as based upon clearly erroneous findings of fact.

The rejection of claim 2 is similarly based upon a clearly erroneous finding of fact. The Examiner clearly erroneously states:

(Deisinger figure 2, element 229 where the user's request is adapted based on the type of service).

Not only is this statement clearly erroneous, it is completely unsupported by the reference. Furthermore, even if true, this would not meet the limitations of claim 2 which requires "a plurality of adapters interposed between said generic gateway and said user terminal". Element 229 of Fig. 2 is not so located. The rejection of claim 2 is respectfully traversed as based upon clearly erroneous findings of fact.

In his rejection of claims 5, 10, and 20, the Examiner states:

Deisinger column 4, lines 40-46 where Windows is the standard operating system for a computer conventionally termed a "PC").

This statement is ambiguous. It is clear that the citation references a plurality of "PC/workstations". Nothing is said of the operating system. Therefore, the operating system limitation is not expressly disclosed by Deisinger. The only other finding which could legally support the Examiner's rejection is inherency of Windows as the operating system. However, the Examiner has clearly not met his burden under MPEP 2112 for showing inherency. Furthermore, because other operating systems could be utilized (e.g., Unix), it seems clear that the Examiner can not meet his

burden. Therefore, the rejection of claims 5, 10, and 20 is respectfully traversed as at least incomplete and probably based upon clearly erroneous findings of fact.

In rejecting claims 6-8, the Examiner states:

Claims 6-8 do not recite limitations above the claimed invention set forth in claims 1-3 and are therefore rejected for the same reasons set forth in the rejection of claims 1-3 above.

This statement is clearly erroneous factually, because claims 6-8 are limited by an additional "server" containing the "generic gateway" which is not limiting of claims 1-3. Therefore, in addition to the arguments made above with regard to the rejection of claims 1-3, the rejection of claims 6-8 is also respectfully traversed as based upon this clearly erroneous finding of fact.

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This statement is clearly erroneous factually as can be readily appreciated by simply reading the claims. In addition, the scope of claims 11 and 16 are different as a matter of law. Claims 1 and 2 are apparatus claims. Claim 11 is a method claim primarily limited by process steps rather than apparatus structure.

Furthermore, claim 16 is an apparatus claim having "means-plus-function" limitations, providing a different statutory basis for patentability. For that reason, examination of claim 16 is to be

performed in accordance with MPEP 2181, et seq. Therefore, the rejection of claims 11 and 16 are respectfully traversed as a matter of law in addition to the arguments made above.

In rejecting claims 12 and 17, the Examiner states:

....transferring said converted and processed service request from said generic gateway to an end service provider via a connector (Deisinger figure 2 and column 5, lines 27-51 where the middleware adapts/converts/processes the requests and routes the it (sic) to the correct server provider via connections 225, 227, etc.).

Thus, instead of addressing Applicants' claim limitations, the Examiner has attempted to redefine them to better comport with his reading of Deisinger. This is procedurally incorrect as a matter of law. The Examiner is reminded that Applicant may be his own "lexicographer" as a matter of law. The Examiner is required to utilize Applicants' definitions. He is not free to choose his own. Page 26, lines 5-8, of the specification should be sufficient to provide the Examiner with a working definition of the claim limitation, "connector". The rejection of claims 12 and 17 are respectfully traversed as contrary to controlling law and as based upon clearly erroneous findings of fact

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This statement is clearly erroneous factually as can be readily appreciated by simply reading the claims. In addition, the scope

of claims 13 and 19 are different as a matter of law. Claim 3 is an apparatus. Claim 13 is a method claim primarily limited by process steps rather than apparatus structure. Furthermore, claim 19 is an apparatus claim having "means-plus-function" limitations, providing a different statutory basis for patentability. For that reason, examination of claim 19 is to be performed in accordance with MPEP 2181, et seq. Therefore, the rejection of claims 13 and 19 are respectfully traversed as a matter of law in addition to the arguments made above.

As with his rejection of claims 12 and 17, the Examiner impermissibly "bends" the terminology of claim 18 to comport with his rejection. The rejection of claim 18 is respectfully traversed as inconsistent with controlling law.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-20, being the only pending claims.

Respectfully submitted,

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By their attorney,

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